REMARKS

Claims 1, 2, 7-14, 24-27 and 39-44 are presently pending. Claims 1, 12 and 13 have been amended to no longer recite that R_1 can be pyridyl, furyl, pyrazolyl or isoxazolyl. Claims 1, 12 and 13 have been further amended to no longer recite that R^5 or R^6 can be $-(CH_2)_\alpha NR_9R_{10}$. Claims 1, 12 and 13 have also been amended to correct an inadvertent typographical error in connection with the spelling of the term "naphthyl." Claim 38 has been canceled without prejudice. No new matter has been added.

Applicant reserves the right to prosecute the subject matter of any canceled, withdrawn or amended claim or any other unclaimed subject matter in one or more continuation, divisional or continuation-in-part applications.

I. Provisional Rejection of Claims 12-14, 24-27 and 39-44 Under the Judicially Created Doctrine of Obviousness-Type Double Patenting

Claims 12-14, 24-27 and 39-44 have been provisionally rejected under the judicially created doctrine of obviousness-type double patenting over claims 1, 17 and 27 of co-pending Application No. 10/004,645 (the "'645 application").

Applicant requests that the rejection of claims 12-14, 24-27 and 39-44 under obviousness-type double patenting be held in abeyance until such time as allowable subject matter of all pending claims is indicated.

Accordingly, Applicant respectfully requests that the provisional rejection of claims 12-14, 24-27 and 39-44 under the judicially created doctrine of obviousness-type double patenting be withdrawn.

II. Rejection of Claims 1, 7, 11 and 38 Under 35 U.S.C. § 102(b or e)

Claims 1, 7, 11 and 38 stand rejected under 35 U.S.C. § 102(b or e) as allegedly anticipated by U.S. Patent No. 6,693,108 to Green *et al.* ("Green"), U.S. Patent No. 6,114,333 to Davis *et al.*, ("Davis I"), U.S. Patent No. 6,552,029 to Davis *et al.* ("Davis II"), U.S. Patent No. 4,788,195 to Torley *et al.* ("Torley I") and U.S. Patent No. 4,876,252 to Torley *et al.* ("Torley II").

Green recites compounds wherein the group corresponding to the variable R_1 of the present claims is furyl, pyrazolyl, triazolyl or isoxazolyl (see Green, column 4, lines 20-27). Amended claim 1 does not recite that R_1 can be furyl, pyrazolyl, triazolyl or isoxazolyl and,

accordingly, is not anticipated by Green. Claims 7 and 11 each depend from claim 1 and, accordingly, are not anticipated by Green.

Davis I and Davis II (a continuation of Davis I) recite compounds wherein the group corresponding to the variable R_1 of the present claims is pyridine (see formula (1) at column 2, lines 1-10 of Davis I and Davis II). Amended claim 1 does not recite that R_1 can be pyridine and, accordingly, is not anticipated by Davis I or Davis II. Claims 7 and 11 each depend from claim 1 and, accordingly, are not anticipated by Davis I or Davis II.

The compounds of the present claims require a phenyl group substituted by $-C(=O)NR^5R^6$. Torley I and Torley II (a division of Torley I) recite compounds wherein the group corresponding to $-C(=O)NR^5R^6$ of the presently claimed compounds is $-C(=O)NH(CH_2)_nNRR$ (*i.e.*, one of R^5 and R^6 is H and the other is $(CH_2)_nNRR$. Claim 1 has been amended to no longer recite that R^5 and R^6 can be $-(CH_2)_aNR_9R_{10}$ and, accordingly, is not anticipated by Torley I or Torley II. Claims 7 and 11 each depend from claim 1 and, accordingly, are not anticipated by Torley I or Torley II.

Claim 38 has been canceled without prejudice.

In view of the above amendments and remarks, Applicant believes the rejection of claims 1, 7, 11 and 38 under 35 U.S.C. § 102(b or e) cannot stand and must be withdrawn.

III. Rejection of Claims 1, 2, 7-14, 24-27 and 38-44 Under 35 U.S.C. § 103(a)

Claims 1, 2, 7-14, 24-27 and 38-44 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Green, Davis I, Davis II, Torley I or Torley II. Applicant respectfully submits that the compounds recited in any of pending claims 1, 2, 7-14, 24-27 or 39-44 are not obvious in view of any of Green, Davis I, Davis II, Torley I or Torley II.

Importantly, none of Green, Davis I, Davis II, Torley I or Torley II recite a compound of any of pending claims 1, 2, 7-14, 24-27 or 39-44. Furthermore, there is no suggestion or motivation found in any of Green, Davis I, Davis II, Torley I or Torley II to modify the compounds recited therein to arrive at the compounds of the present claims. When a new chemical entity is claimed, a *prima facie* case of obviousness requires that the prior art suggest the claimed compounds to a person of ordinary skill in the art. *In re Deuel*, 51 F.3d 1552, 1557 (Fed. Cir. 1995). Furthermore, in addition to such suggestion, a reasonable expectation of success is also required in order to support a *prima facie* case of obviousness. *In re Vaeck*, 947 F.2d 488, 493 (Fed. Cir. 1991).

In addition, the Federal Circuit has expressly required that "there must be adequate support in the prior art for the ... change in structure, in order to complete the PTO's *prima facie* case [of obviousness] and shift the burden of going forward to the applicant." *In re Grabiak*, 769 F.2d 729, 731-732 (Fed. Cir. 1985). In *Grabiak*, the court expressly stated that in the absence of a reference showing or suggesting the change, there is inadequate support for a *prima facie* case of obviousness. *Id.* at 732. Thus, in view of *Grabiak*, for a compound that differs from the prior art by at least one atom to be obvious, the Examiner must provide a secondary reference that teaches the interchangeability of such at least one atom of the claimed compound with the corresponding atom of the prior art.

The presently claimed compounds differ from those of Green, Davis I and Davis II by at least an entire cyclic group at the R_1 position and differ from Torley I and Torley II at least by the groups at the R^5 and R^6 positions. No reference has been provided which teaches the interchangeability of the presently claimed R_1 groups with those of Green, Davis I or Davis II or the presently claimed R^5 and R^6 groups with those of Torley I or Torley II. Without such a reference, the obviousness rejection of pending claims 1, 2, 7-14, 24-27 and 39-44 is unsupported and cannot stand. Thus, Applicant submits that a proper *prima facie* case of obviousness has not been shown. In the absence of a proper *prima facie* case of obviousness, an applicant who complies with the other statutory requirements is entitled to a patent. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

In view of the above amendments and remarks, Applicant believes the rejection of claims 1, 2, 7-14, 24-27 and 38-44 under 35 U.S.C. § 103(a) cannot stand and must be withdrawn.

IV. References CG and DD

Applicant submits herewith a supplemental Form PTO-1449 listing literature reference DD with the date provided. Although the Examiner also refers to literature reference CH, it appears that literature reference CG was intended. The date of literature reference CG was previously supplied by Applicant and considered by Examiner Ford on January 15, 2004. A copy of a Form PTO-1449 form with literature reference CG (with publication date provided) initialed by Examiner Ford is attached hereto.

Applicant respectfully requests that the Examiner review the reference identified as DD on the supplemental Form PTO-1449 submitted herewith, and that it be made of record in the file history of the above-identified application.

V. Conclusion

Applicant respectfully requests that the present remarks be made of record in the file history of the present application. An early allowance of the application is earnestly requested. The Examiner is invited to call the undersigned with any questions concerning the foregoing.

It is believed that no fee is due other than that for the extension of time; however, in the event any other fee is required, please charge the required fee to Jones Day Deposit Account No. 50-3013.

Respectfully submitted,

Anthony M. Insogna, Reg. No. 35,203
By: Michael J. Bruner, Reg. No. 47,458

Date February 15, 2005

By: Michael J. Bruner (Reg. No. 47,458)
For: Anthony M. Insogna (Reg. No. 35,203)
JONES DAY
222 East 41st Street
New York, New York 10017
(858) 314-1130

Enclosures